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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,014	11/27/2001	Kyoji Saito	P20707	9427
7055	7590	03/23/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			LETT, THOMAS J	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,014

Applicant(s)

SAITO, KYOJI

Examiner

Thomas J. Lett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Budge et al (USPN 6,564,248 B1).

With respect to claim 1, Budge et al disclose a dial-up internet facsimile apparatus (PC 10, see Fig. 1) comprising:

a modem (network interface 6A which allows digital data to be transmitted over a PSTN on communications line 8, and see Fig. 2C) that makes dial-up connection to a service provider of e-mail via telephone line;

an operation section that has a stop button (STOP button 620), and

an e-mail reception section (video email recorder 210, Fig. 2B) that receives e-mail data from the connected service provider (video input device 20 and device electronics 22) and that, when the stop button is pressed while receiving the email data, disconnects the connection to the service provider (stops recording the email when the Stop button 620 is pressed, col. 6, lines 3-5) without waiting for the completion of the e-mail data reception.

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With respect to claim 2, Budge et al disclose a dial-up internet facsimile apparatus according to the claim 1, wherein said e-mail reception section (video email recorder 210, Fig. 2B) that receives the e-mail data by a message unit (received from "Microsoft Video for Windows", see Fig. 2B).

With respect to claim 3, Budge et al disclose a dial-up internet facsimile apparatus according to the claim 1,

wherein said e-mail reception section (video email recorder 210, Fig. 2B), when receiving the e-mail data from the service provider, detects (stops recording, col. 6, lines 3-5) whether the e-mail data is the one that was disconnected while being received previously;

wherein the e-mail reception section (video email recorder 210, Fig. 2B), when the e-mail data is the one that was disconnected previously, does not receive the e-mail data (stops recording, col. 6, lines 3-5).

With respect to claim 4, Budge et al a dial-up internet facsimile apparatus (client computer 1080), comprising:

a modem (dial-up modem of Prioritizing Access/Router in Fig. 19G) that makes dial-up connection to a service provider of e-mail via telephone line;

an operation section that has a stop button (message retrieval), and

an e-mail reception section that receives e-mail data from the connected service provider and that, when the stop button is pressed while receiving the email data (message retrieval provides subscribers the ability to selectively retrieve email messages that reside in the "universal inbox", col. 180, lines 41-44), interrupts the

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reception of the e-mail from the service provider without waiting for the completion of the e-mail data reception, said e-mail reception section going to the reception of the next e-mail data (selectively retrieve) after the interrupted e-mail data regards as the received e-mail data.

With respect to claim 5, Budge et al a dial-up internet facsimile apparatus according to the claim 4, comprising:

wherein said e-mail reception section sets a flag when the email data is regarded as the interrupted e-mail data (system subscribers receive an accounting of current messages across a number of media, to include voicemail, faxmail, email, paging, col. 65, lines 44-46).

2. Claims 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Elliott et al (USPN 6,754,181 B1).

With respect to claim 7, Elliot et al disclose a dial-up internet facsimile apparatus (client computer 1080), comprising:

a modem section (dial-up modem of Prioritizing Access/Router in Fig. 19G) that makes dial-up connection to a service provider of email via telephone line, and

an e-mail reception section that receives a size of e-mail data from the service provider before receiving the email data, and eliminates e-mail over predetermined size from e-mails to be received (prior to retrieving messages, search criteria such as message size eliminates messages of a predetermined message size from being retrieved, col. 180, lines 54-67).

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With respect to claim 8, Elliot et al disclose a method of receiving e-mail data, comprising:

making dial-up connection to a service provider of e-mail via telephone line (using(dial-up modem of Prioritizing Access/Router in Fig. 19G);

receiving e-mail data (message retrieval, col. 180, line 40) from the connected service provider (from the "universal inbox", col. 180, lines 41-43), and disconnecting, when a stop button on a panel is pressed while receiving the email data (message retrieval provides subscribers the ability to selectively retrieve email messages that reside in the "universal inbox", col. 180, lines 41-44), the connection to the service provider without waiting for the completion of the e-mail data reception.

With respect to claim 9, Elliot et al disclose a method of receiving e-mail data, comprising:

making dial-up connection to a service provider of e-mail via telephone line (using(dial-up modem of Prioritizing Access/Router in Fig. 19G);

receiving e-mail data (message retrieval, col. 180, line 40) from the connected service provider (from the "universal inbox", col. 180, lines 41-43);

interrupting, when a stop button on a panel is pressed while receiving the email data, the reception of the e-mail data from the service provider without waiting for the completion of the e-mail data reception, and going to the reception of the next e-mail data after the interrupted email data regards as the received e-mail data (message retrieval provides subscribers the ability to selectively retrieve email messages that reside in the "universal inbox", col. 180, lines 41-44).

With respect to claim 10, Elliot et al disclose a method of receiving e-mail data, comprising:

making dial-up connection to a service provider of e-mail via telephone line, and receiving a size of e-mail data (selective retrieval of messages based on message size prior to receiving, col. 180, lines 54-67) from the service provider before receiving the email data;

eliminating e-mail over predetermined size from e-mails to be received, and receiving the e-mail data that is not eliminated from the e-mail data to be received from the service provider (prior to retrieving messages, search criteria such as message size eliminates messages of a predetermined message size from being retrieved, col. 180, lines 54-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Budge et al (USPN 6,564,248 B1) in view of Elliott et al (USPN 6,754,181 B1).

Budge et al does not disclose a dial-up internet facsimile apparatus according to claim 1, further comprising: an error notification section that transmits an error notification mail to the sender of the e-mail data when the e-mail data reception is

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interrupted. Elliott et al discloses a client device 1080 wherein system subscribers receive an accounting of current messages across a number of media, to include voicemail, faxmail, email, paging, col. 65, lines 44-46. Budge et al and Elliott et al are analogous art because they are from the similar problem solving area of email management. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the notification feature of Elliott et al to Budge et al in order to obtain a device capable notifying a status of a message. The motivation for doing so would be to notify the status of a message to a sender.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is 703-305-8733. The examiner can normally be reached on 7-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on 703-305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJL

TJL

KAW Williams

**KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER**